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In the Supreme Court
OF THE
United States

OCTOBER TERM, 1966

No. 363

In the Matter of the Application
of
ARTHUR L. REESE.

PETITION FOR A WRIT OF CERTIORARI
to the United States Court of Customs
and Patent Appeals

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PETITION FOR A WRIT OF CERTIORARI
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and Patent Appeals

Petitioner[1] prays that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals entered in the above-entitled case on April 21, 1966.

CITATIONS TO OPINIONS BELOW

The decision of the Court of Customs and Patent Appeals and the dissenting opinion of Judge Smith

[1]The patent rights involved in the application of Arthur L. Reese have been assigned to California Pellet Mill Company, a California corporation.

are printed in Appendix B hereto, infra, p. 4, and are reported in 359 F.2d 462 (149 USPQ 362).

The first judgment of the Court of Customs and Patent Appeals is unreported and is printed in Appendix B hereto, infra, p. 29.

JURISDICTION

The Court of Customs and Patent Appeals entered a judgment November 4, 1965. A decision on rehearing was entered on April 21, 1966. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

QUESTION PRESENTED

Whether petitioner's appeal to the Court of Customs and Patent Appeals was timely within the provisions of the Patent Office Rules of Practice.

STATUTES AND RULES INVOLVED

Under 35 U.S.C. 141, an applicant dissatisfied with the decision of the Patent Office Board of Appeals may appeal to the Court of Customs and Patent Appeals. The time for appealing to that Court is governed by Rule 304 of the Patent Office Rules of Practice promulgated in accordance with 35 U.S.C. 142. Patent Office Rule 197(b) indicates that where the decision of the Board of Appeals is so changed as to become a "new decision", the post-decision review process of Rule 304 begins all over again.

STATEMENT

It is believed that a chronological table of events will be helpful to understanding the question in issue:

Date	Action	Lapse of Time
Oct. 11, 1963	Applicant appealed to Board of Appeals	Timely
June 29, 1964	Board of Appeals' original decision	262 days
July 24, 1964	Appellant requested reconsideration	25 days
Sept. 21, 1964	Board of Appeals' decision on reconsideration	59 days
Sept. 24, 1964	Appellant's second request for reconsideration	3 days
Oct. 16, 1964	Board of Appeals' second decision on reconsideration	22 days
Nov. 2, 1964	Appellant filed notice of Appeal to Court of Customs and Patent Appeals	17 days
Jan. 15, 1965	Appellant paid for printing of record	
Aug. 25, 1965	Appellant's brief filed	
Sept. 22, 1965	Solicitor requested stipulation to extend time for filing brief and *moved to dismiss* and extend time for filing of brief by the Commissioner of Patents	324 days

In the prosecution of the Reese application before the Patent Office, the Primary Examiner rejected all of the claims. An appeal was taken to the Patent Office Board of Appeals. In its first decision, dated June 29, 1964, the Board acknowledged the pertinence

of Appellant's arguments and reversed the Examiner as to three of the six appealed claims. Concurrently, however, the Board placed an unwarranted restrictive interpretation on the scope of the claims it had allowed. On July 24, 1964, appellant petitioned for reconsideration of the Board's decision. The Board granted the petition, and, in a second decision, dated September 21, 1964, admitted the correctness of appellant's contentions. The Board accordingly reversed itself as to the remaining claims, thereby allowing all of the appealed claims, but maintained the restriction on the scope of the claims and stated for the first time its reason for such restriction. Appellant, on September 24, 1964, relying on the second decision of the Board as a "new decision", presented a second petition for reconsideration, under provision 197(b) of the Patent Office Rules of Practice, directed solely to the removal of the restriction. The Board of Appeals granted the petition and, on October 16, 1964, rendered a third decision, maintaining, but changing the reason for, the restriction on the scope of the claims. Seventeen days after the Board's third decision, appellant filed his notice of appeal to the Court of Customs and Patent Appeals under Rule 304 of the Rules of Practice of the Patent Office. Three hundred and twenty-four days after appellant filed his notice of appeal, on September 22, 1965, the Commissioner of Patents belatedly moved that the appeal be dismissed because (1) the Court lacked jurisdiction to determine the issues raised by appellant's reasons of appeal, and because (2) the appeal was not filed timely under Patent Office Rule 304. On November 4, 1965, the

Court of Customs and Patent Appeals granted the motion on the second ground with two of the five judges dissenting. Thereafter, appellant Reese filed a petition for rehearing and moved to vacate the order of dismissal. The petition and motion were considered, and, on April 21, 1966, the Court of Customs and Patent Appeals affirmed its prior decision holding that the second petition for reconsideration to the Board of Appeals (and consequently the third decision of the Board in response thereto) was "irrelevant" to the timely filing of an appeal to the Court. An extended dissenting opinion was rendered by Judge Smith.

REASONS FOR GRANTING THE WRIT

1. By holding that appellant's second petition for reconsideration to the Board of Appeals was "irrelevant" to the timely filing of an appeal to the Court of Customs and Patent Appeals, and overlooking the fact that a third decision was rendered by the Board in response thereto, the Court of Customs and Patent Appeals has so far departed from the accepted and usual course of judicial proceedings that it calls for an exercise of the supervisory power of the United States Supreme Court under 28 U.S.C. 1256. The erroneousness of the Court's interpretation of the Patent Office Rules of Practice, to dismiss appellant's appeal, is clearly and cogently set forth in the dissenting opinion of Judge Smith to which reference is hereby made.

2. The inequity to Reese and his assignee resulting from the dismissal of his appeal by the Court of Customs and Patent Appeals is substantial. The Board of Appeals placed a restriction on the scope of appellant's allowed claims even though, in its second decision, the Board declared appellant's invention to be unanticipated. In that second decision, the Board reversed the holding of its first decision as to the remaining three claims it had rejected, and, for the first time, stated its reasons for restricting in its original decision the scope of the allowed claims. Appellant therefore was led to believe that a "new decision" had been rendered in the case, as provided for in Rule 197(b) of the Rules of Practice, and that the time for appealing to the Court of Customs and Patent Appeals would be thirty days after a decision on reconsideration as set forth in Rule 304. In dismissing the appeal, the Court has held that the Board's second decision was not a "new decision" since it was not an "adverse" decision. The second decision was, in truth and in fact, an adverse decision as it maintained the restriction on the scope of coverage of appellant's claims and remained adverse despite the fact the Court allowed the rest of the rejected claims. The Court was patently oblivious to the inequity to the appellant, which should have been obvious from the very facts stated in the Court's decision. The inequity is particularly pointed out in the dissenting opinion of Judge Smith.

3. The decision of the Court of Customs and Patent Appeals, in dismissing the subject appeal, creates a

precedent for the Commissioner of Patents and the Board of Appeals to use against all applications prosecuted before the Patent Office, which is ultra vires in its effect. The Court's decision forms the basis for denying appeals to the Court of Customs and Patent Appeals where the Board of Appeals' decisions have not been "adverse" to the applicants (see footnote 1, last line of the Court's decision), but this unlawfully denies applicants their rights of appeal as guaranteed under 35 U.S.C. 141 which gives any applicant "dissatisfied" with the decision of the Board of Appeals the right to appeal to the Court of Customs and Patent Appeals. The statute does not say that only, to quote the Court, "adverse decisions . . . are the proper subject of an appeal". Under the facts of petitioner's case, where all of the claims were allowed, but with a limiting restriction placed on the scope of their coverage, it seems that the Court of Customs and Patent Appeals has empowered the Board of Appeals to completely emasculate the claims of any application which comes before the Board on appeal, so long as the claims, as so emasculated, are allowed, and that such a decision will not be considered as an "adverse" decision which would entitle the applicant to a review by the Court of Customs and Patent Appeals. By this holding the Court exceeds its authority and seeks to avoid its duty of reviewing cases it is obligated to accept. The Court's decision must be reversed and the statutory language of 35 U.S.C. 141, as to what constitutes the grounds for appeal, reinstated.

CONCLUSION

For the foregoing reasons, this petition for writ of Certiorari should be granted. Applicant relies heavily on the dissenting opinion of Judge Smith of the Court of Customs and Patent Appeals for support.

Dated, Berkeley, California,
July 14, 1966.

Respectfully submitted
CHARLES O. BRUCE,
Counsel for Petitioner.

ERNEST H. MCCOY,
Of Counsel.

(Appendices Follow)

Appendix A

STATUTES

28 U.S.C. § 1256. *Court of Customs and Patent Appeals; certiorari.* Cases in the Court of Customs and Patent Appeals may be reviewed in the Supreme Court by writ of certiorari.

35 U.S.C. 141. Appeal to Court of Customs and Patent Appeals. An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

35 U.S.C. 142. Notice of appeal. When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office

his reasons of appeal, specifically set forth in writing within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.

PATENT OFFICE RULES OF PRACTICE

197. Action following decision. (a) After decision by the Board of Appeals, the case shall be returned to the primary examiner, subject to the applicant's right of appeal or other review, for such further action by the applicant or by the primary examiner, as the condition of the case may require, to carry into effect the decision.

(b) Any request or petition for rehearing or reconsideration, or modification of the decision, must be filed within thirty days from the date of the original decision, unless that decision is so modified as to become, in effect, a new decision, and the Board of Appeals so states.

(c) When an appeal is or stands dismissed, or when the time for appeal to the court or review by civil action (rule 304) has expired and no such appeal or civil action has been filed, proceedings in the application are considered terminated as of the dismissal or expiration date except in those applications in which claims stand allowed or in which the nature of the decision requires further action by the examiner. If an appeal to the court or a civil action has been filed, proceedings in the application are similarly considered terminated when the appeal or civil action is terminated.

304. Time for appeal or civil action. The time for filing the notice and reasons of appeal to the U.S. Court of Customs and Patent Appeals (rule 302) or for commencing a civil action (rule 303) is sixty days from the date of the decision of the Board of Appeals or the Board of Patent Interferences. If a petition for rehearing or reconsideration is filed within thirty days after the date of the decision of the Board of Appeals or Board of Patent Interferences, the time is extended to thirty days after action on the petition. No petition for rehearing or reconsideration filed outside the time specified herein after such decision, nor any proceedings on such petition shall operate to extend the period of sixty days hereinabove provided. The times specified herein are calendar days. If the last day of the time specified for appeal or commencing a civil action falls on a Saturday, Sunday or legal holiday, the time is extended to the next day which is neither a Saturday, Sunday nor a holiday. If a defeated party to an interference has taken an appeal to the U.S. Court of Customs and Patent Appeals and an adverse party has filed notice under 35 U.S.C. 141 that he elects to have all further proceedings conducted under 35 U.S.C. 146 (rule 303(c)), the time for filing a civil action thereafter is specified in 35 U.S.C. 141.

Appendix B

United States Court of Customs and Patent Appeals

October Term 1965

Patent Appeal No. 7596

In the Matter of the Application
of
ARTHUR L. REESE.

April 21, 1966

Per Curiam:

Appellant has (1) filed a petition for rehearing of our order granting the motion of the Patent Office to dismiss his appeal on the ground that it was not timely filed and (2) moves to vacate said order.

The petitioner argues, as he did in the opposition to the Patent Office motion, that he is entitled to the "benefit" of Patent Office Rule 197(b). The lengthy petition is mostly devoted to arguing why appellant is entitled to that "benefit."

Assuming, arguendo, that appellant is entitled to whatever benefit is to be had from Rule 197(b), though he admits that he has not technically come within its provisions, we think that rule is not ger-

mane to the issue here. It relates only to the time for a request or petition to the Board of Appeals for a rehearing or reconsideration or modification of its decision by it, not by us.

The time for appealing to this court is governed by Patent Office Rule 304, promulgated in accordance with 35 USC 142, and appellant makes no contention that he has complied with that rule. Rather, he argues that Rule 197(b) provides for an exception to Rule 304. That is not the fact.

The application of Rule 304 to the facts here is as follows: the 60-day provision, measuring from the original decision of the board on June 29, 1964, does not apply because a timely petition for rehearing was filed on July 24, 1964. The decision on the petition was dated September 21, 1964, which started the 30-day provision in Rule 304 running.[1] Under the rule, the time for appeal expired October 21, 1964, and the notice of appeal was not filed until 12 days thereafter.

While the times for taking appeal are stated in a Patent Office rule, compliance with them is required

[1]Petitioner filed a second request for reconsideration with the board September 24, 1964, which was denied with an opinion on October 16, 1964, except for the consideration given to it. We deem that second request irrelevant since, regardless of appellant's contention, the date of *the decision* appealed from is June 29, notwithstanding the fact the *opinion* dated September 21 provided additional *reasons* for that earlier decision and also notwithstanding the board's action on September 21 constituted a "new" decision to the extent the board changed its earlier position on a rejection of three other claims, not on appeal, from an affirmance to a reversal. Adverse *decisions,* not their supporting reasons, are the proper subject of an appeal.

by statute. 35 USC 142 provides that an applicant *shall* file his notice of appeal within such time as the Commissioner appoints (not less than sixty days from "the date of the decision appealed from") and it is mandatory. We are without power to waive the requirement.[2]

Furthermore, Rule 197(c), which makes express reference to Rule 304, contains the further provision that "proceedings in the application are considered terminated as of the * * * expiration" of the time to appeal, set by Rule 304, in the event an appeal has not been timely taken. In this case proceedings did so terminate October 21, 1964, and notice of appeal was not filed until November 2, 1964.

Appellant's petition has been granted to the extent that we have reconsidered, but is otherwise denied. The motion to vacate is denied.

---

[2]This is not to say *the Commissioner* is without power to waive the requirement of Rule 304, for he clearly can under the provision of Rule 183. *Eckey v. Watson*, 268 F. 2d 891 (D.C. Cir.). The question of the applicability of that rule not being before us, however, we express no views regarding appellant's rights should he rely on Rule 183.

United States Court of Customs and Patent Appeals

October Term 1965

Patent Appeal No. 7596
Serial No. 106,914

In the Matter of the Application
of
ARTHUR L. REESE.

April 21, 1966

Smith, Judge, dissenting.

The determination of issues raised in a petition for reconsideration should not ordinarily engender either a lengthy majority opinion or a lengthy dissent. The office of a petition for rehearing under our Rule 7 is to bring to the court's attention matters of substance which may have been "overlooked or misapprehended" in the original determination of the issue. The instant case is an exception and seems to me to require an elaboration of the reasons for my dissent from the original majority decision which was predicated on points I believe were "overlooked or misapprehended" in the original opinion and hence are of continuing significance in my dissent from the de-

cision of the majority to deny the petition for rehearing.

In the instant case, the motion to dismiss appellant's appeal was granted without opinion. I then dissented from the granting of that motion, also without stating my reasons. Now the majority has decided to state its reasons for its original decision and to do so utilizes the petition for rehearing as its platform and I shall do likewise.

A statement of the facts which gave rise to the petition for rehearing in this case is essential to an understanding of the legal issue presented to this court for determination. I believe the facts show that appellant's appeal was timely under the *Patent Office Rules*, that the majority denies him his day in court, and therefore that appellant has been denied due process of law.

The facts are as follows: Appellant filed a timely appeal to the Patent Office Board of Appeals from the examiner's final rejection of claims 1 through 6. On June 29, 1964, the board rendered a decision (which the majority here calls "the original decision") in which the examiner's rejection as to claims 3, 4 and 6 was *reversed;* and *sustained* the rejection of claims 1, 2 and 5, stating "we have no evidence presented for consideration leading to a contrary conclusion."

On July 24, 1964, some 25 days after the board's "original decision," appellant filed a petition for rehearing of the board's decision. In this petition, appellant pointed out that:

> On the bottom of page 9 of its decision, the board has given some indication that it would be amenable to evidence leading to a conclusion contrary to its holding as to claims 1, 2 and 5, and it is believed the foregoing discussion of claims 1, 2 and 5 will provide adequate basis for such consideration.

Appellant also argued that the board erred in its interpretation of claims 3, 4 and 6.

On September 21, 1964, some 84 days after its "original decision," the board took "action on the petition," stating as follows:

> This is a petition for reconsideration of our decision dated June 29, 1964.
>
> * * *
>
> Appellants' second point is that we were in error in our treatment of claims 1, 2 and 5 and the reason why we were in error. * * *
>
> We have considered appellant's contentions and find that he is correct. As will be apparent from our opinion, we [erred] * * *. Therefore, we modify our decision and *reverse the rejection of claims 1, 2 and 5.* [Emphasis added.]

The board additionally stated that (1) its interpretation of appealed claims 3, 4 and 6 in its "original decision" did not place an unreasonable limitation on those claims, and (2) it was "of the opinion that the present claims, consonant with the tenor of the petition, do not properly protect the novel concept which is clearly patentable over the prior art * * *." The board then recommended allowance of a new claim.

I would state at this point that I agree with appellant's argument that the above opinion by the board was a "new decision." Where a lawfully composed legal entity empowered to render decisions, after reconsidering the evidence before it, *reverses* its position and reinterprets the prior art, it is clear to me that a *new* decision has been made.[1] Applying the terms of Rule 304 to this decision as shown infra, it is readily seen that appellant's notice of appeal was *timely filed,* being within 30 days after "action on the petition" (Rule 304) for rehearing directed to this "new decision" (Rule 197(b)) which is "the decision appealed from." 35 USC 142.

On September 24, 1964, some 87 days after the "original decision" and 3 days after the "new decision," appellant filed a request for reconsideration

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[1]Finding as I do that the board rendered a new decision does not resolve the broader question, which factually is the paramount concern of the Patent Office in this case, of whether an applicant has the right to appeal from a board decision wherein the examiner's rejection is reversed and all appealed claims stand allowed. 35 USC 141.

The solicitor, however, refuses to separate these two inquiries. He argues that the board's second decision was not "new" because it is not "adverse" and did not set forth anything "new" as to the claims finally appealed. The solicitor's argument is that an appeal is taken as to *claims* and not from *decisions* and that the time within which to file a notice of appeal as to those claims runs from the date that the board took action on those claims. The solicitor's argument requires the conclusion that different times for filing an appeal may exist, depending when the board took action on different claims. This I find to be a totally unworkable scheme of appeal which is certainly not contemplated by the Rules. For purposes of orderly procedure, consistent with due process of law, I find that the board rendered a new decision and the appeal is taken from the decision as a whole and not only that portion of the decision dealing with a given claim.

as to claims 3, 4 and 6, submitting in his request a diagram in support of his arguments.

The board, on October 16, 1964, some 109 days after its "original decision," and some 22 days after its "new decision," rendered a third opinion, stating as follows:

> This is a second petition for reconsideration in the instant case.
>
> It is not our custom to entertain a second petition for reconsideration outside of the period specified by Rule 197(b). [Rule 197(b) provides, "Any request or petition for rehearing or reconsideration, or modification of the decision, must be filed within thirty days from the date of the original decision, unless that decision is so modified as to become, in effect, a new decision, and the Board of Appeals so states."] *However, under the special facts of the instant case, we are making an exception and will entertain the instant petition.* [Emphasis added.]
>
> * * *
>
> The petition has been *granted* to the extent that we have considered the same but is denied with respect to making any change in our opinion in the case or opinion on the first request for reconsideration. [Emphasis added.]

On November 2, 1964, the appellant filed in the Patent Office a notice of appeal to this court. This was some 126 days after the board's "original decision," some 42 days after the board's "new decision" reversing its holding as to claims 1, 2 and 5, and some 17 days after the board's third opinion granting ap-

pellant's second request for reconsideration wherein the board refused to make any change in its "opinion in the case."

Thereafter appellant perfected his appeal to this court. In January of 1965 appellant sent to the Clerk of this Court a check for $265.00 to cover the estimated cost of printing the record. In August of 1965, twenty-five copies of appellant's brief were delivered to the Clerk of this Court.

On September 22, 1965, after receipt by the Clerk of the printed brief and record, some 321 days after the third opinion by the board (October 16, 1964), the Commissioner of Patents filed a motion to extend time to file a brief as to the merits and to dismiss the appeal "because (1) the court lacks jurisdiction to determine the issues raised by appellant's reasons of appeal (R-42), and because (2) the appeal was not filed timely under Patent Office Rule 304." This motion was granted based on ground (2), Judge Almond and myself dissenting. Appellant then filed the present petition for rehearing, which is now before the court for decision.

In passing, it seems to me the delay on the part of the solicitor in making the present motion to dismiss strongly suggests that the time factor in the present appeal here is not as certain as one might suppose from reading the majority opinion and the solicitor's belated motion. To me it savors of the unconscionable to encourage such a technical approach to a problem in the administration of justice. Appellant here had

perfected his appeal and carried it far beyond the point where any judicial tribunal should see fit to approve the rigid and unfounded technical approach here urged by the solicitor. It is the sometimes forgotten duty of the courts, despite heavy dockets, to give a litigant his day in court. It seems to me it also should be the duty of the Patent Office to encourage and assist litigants through its maze of rules and regulations (written and unwritten) to the end that he too should have his day in court. As a public agency it should be particularly alert to serve the best interests of the public which supports it instead of playing a technical "rule" game with those who would appeal its decisions. This entire proceeding here seems to me to be so foreign to modern jurisprudential concepts that it argues strongly for basic and far reaching reforms in Patent Office appeal procedures.

It is my view, despite contrary indications in the majority, that it is our duty as a court to construe the statute and the various rules of the Patent Office in *pari materia* to the end that the right of litigants be preserved wherever possible.

As I see it, and the majority agrees, the issue before the court is whether appellant's appeal was timely within the provisions of Rule 304 when so construed.

It appears to be the majority opinion that:

> The time for appealing to this court is governed by Patent Office Rule 304, promulgated in accordance with 35 USC 142, and *appellant makes no contention that he has complied with that rule.* [Emphasis added.]

I find this position to be contrary to the facts of record. Appellant has argued before this court that the board's decision of September 21, 1964 (the second opinion) was a "new decision." He then interpreted Rule 304 as follows:

> Thus appellant was required to file his appeal within thirty days of the date of the Board's decision on his petition for reconsideration. Such decision was dated October 16, 1964, and *appellant in compliance with Rule 304* filed his appeal on November 2, 1964, and well within the time allowed therefor.[2] [Emphasis added.]

---

[2]See appellant's "Opposition to Motion to Dismiss," filed October 11, 1965, at p. 6. Appellant argues in the present petition for rehearing that the board's action was a new decision, in accordance with the Patent Office Rules, and therefore that his appeal was filed timely within the periods specified by the Rules.

Appellant also argues that the Commissioner should be estopped from arguing here that the second decision of the board was not a new decision, first, because the Commissioner did not oppose the second petition for rehearing and therefore has waived any right to protest here; second, as the Commissioner *is* a member of the board, 35 USC 7, he is therefore estopped from contesting that the granting of a second petition for rehearing resulted in a new decision; and third, as appellant relied, to his detriment on the Commissioner's silence, an equitable estoppel arises in his favor preventing the Commissioner from contesting that the board rendered a new decision.

The majority does not deal with the above arguments nor does the solicitor answer them. While I prefer to hold for appellant on the ground that the appeal was timely filed within the meaning of the Rules, and therefore do not feel that the above arguments are necessary to succeed here, the Supreme Court has recently stated, in *Brenner v. Manson*, ... U.S. .....; 148 USPQ 689, in footnote 6 concerning the Commissioner:

> * * * As a member of the Board and the official responsible for selecting the membership of its panels, 35 U.S.C. § 7 (1964 ed.), it may be considered appropriate that the Commissioner be bound by Board determinations.

Appellant's arguments that the Commissioner, in effect, here refuses to be bound by the board's determination, become all the more convincing.

Rule 304 may now be examined. The relevant portions may be conveniently grouped as follows:

1. The time for filing the notice and reasons of appeal to the U.S. Court of Customs and Patent Appeals * * * is sixty days from the date of the decision of the Board of Appeals * * *.
2. If a petition for rehearing or reconsideration is filed within thirty days after the date of the decision of the Board of Appeals * * * the time is extended to thirty days after action on the petition.
3. No petition for rehearing or reconsideration filed outside the time specified herein after such decision, nor any proceedings on such petition shall operate to extend the period of sixty days hereinabove provided.

It is apparent that the portions identified as (1) and (2) above must be read together as they provide two alternatives for the dissatisfied litigant: either, under (1), file a notice of appeal within 60 days or, under (2), file a "petition for rehearing or reconsideration" within 30 days. In either case the period runs from *"the decision"* of the board. Where a petition for rehearing or reconsideration is filed, the 60 day period under (1) for filing the notice of appeal to this court is inapplicable. Under (2) appellant then has 30 days after "action on the petition" to file the notice of appeal to this court.

It also is apparent that the portion of Rule 304 identified under (3) above covers the period from 30 to 60 days after the "decision" of the board as it

states the consequences of filing a petition outside the 30 day period specified in the rule. It recognizes that timely petitions under the rule may extend the time for filing a notice of appeal to this court and no petition filed after 30 days from the "decision" or any proceeding thereon can operate to extend the 60 day period specified in (1). The solicitor's argument, in his original motion to dismiss the appeal, that the portion of Rule 304 here considered under grouping (3) set the time for filing notice of appeal at 60 days after the board's "original decision" is obviously in error as in this case the provisions grouped under (2) above then would be a nullity.

For purposes of this appeal, the portions of Rule 304 grouped under pars. (1) and (3) above are inapplicable as appellant filed a timely petition for rehearing under (2). The majority so admits as to (1) but it ignores what I consider to be the relevant considerations grouped under (3) above.

Can Rule 304 be of any further help in determining the timeliness of appellant's appeal? The critical facts as to which Rule 304 must be applied are as follows: On September 21, 1964, the board took "action on the [first] petition." According to grouping (2) of the provisions of Rule 304, appellant had 30 days within which to file a notice of appeal and the board retained jurisdiction in the case for that period. The record shows that appellant, during this period, filed a *second* petition for rehearing. The board, within this period, took "action on the [second] petition." Appellant filed his notice of appeal 17 days thereafter, *more* than 30

days after action on the *first petition* but *less* than 30 days from action on the *second petition.*

The majority so interprets Rule 304 as to find "the time for appeal expired October 21, 1964," which is 30 days after the board took "action on the [first] petition." The majority reasons that the second petition is "irrelevant since * * * the date of the decision appealed from is June 29 * * *."

The construction of the rule or reasoning in support thereof which the majority thus places on Rule 304 is not clear to me. From the holding of the majority it seems that its position is that (1) a *first* petition *irrevocably* sets the time within which to file notice of appeal, i.e., 30 days after "action on the petition;" (2) second petitions are "irrelevant;" and (3) an applicant shall file his notice within the time fixed by 35 USC 142, which the majority considers to be a mandatory provision; and (4) on the facts of this case Rule 304 provides that the time for appeal expired October 21, 1964.

My objections to the majority's position are as follows: (1) Rule 304 does not provide that there shall be but *one* petition which *irrevocably* sets the time for filing notice of appeal; (2) second petitions are not "irrelevant" as shown by past decisions of this court (see e.g., *In re Schutte,* 44 CCPA 922, 244 F. 2d 323, 113 USPQ 537); (3) Rule 304 is silent on its face as to the time for appeal in this case; and (4) 35 USC 142 is both a prohibition against the Commissioner and a source of discretionary authority as the Com-

missioner *must* exercise his *discretion* when requested to accept for filing a notice of appeal outside the time limits specified in Rule 304, *Eckey v. Watson,* 268 F. 2d 891 (D.C.C.A. 1959).

I do not believe that the majority meets or decides what seems to me to be the issue before us, i.e., where does a second petition for rehearing, if such is a lawful method of redress, fit into the plan of appeal regarding timeliness? First, it is clear that Rule 304 or any other Patent Office rule cannot require the board, when it is vested with jurisdiction, to *grant* or *deny* a rehearing. 35 USC 7 states: "The Board of Appeals has sole power to grant rehearings," and 35 USC 6 provides that the Commissioner "may * * * establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office." There is no prohibition by rule or by statute which prevents the filing of such a second petition for rehearing. Thus, appellant proceeded lawfully in submitting the second petition for rehearing to the board which then had jurisdiction over the case. The Commissioner had no authority to prevent the board from *granting* such a second petition for *rehearing.*

Thus, second petitions are not to be considered "irrelevant" as the majority does. Assuming the board desires to entertain a second petition, is its power to grant a rehearing subject to the time bar the majority finds in Rule 304? I cannot imagine the board's power to be so limited as the Commissioner clearly lacks authority to control the board's exercise of its power as to such petitions, 35 USC 6, 7. What the Commis-

sioner may not do directly he cannot do indirectly through Rule 304.

In the fact situation before us the board exercised its lawful power and it granted the second petition for rehearing within the 30 day period following its "action on the [first] petition." At that time there remained 5 days in which to file a notice of appeal within 30 days after action on the first petition under Rule 304.

Would this fact be fatal to appellant's right to appeal, i.e., does Rule 304 require that appellant file a notice of appeal within this 5 day period? I do not believe so. It is obvious that the board in some cases may require more time in considering a second petition for rehearing. The 30 day period following action on the first petition wherein the board rendered a new decision could well have run before the board took action on the second petition. As the board had jurisdiction when the petition was filed, I believe that it was entitled to as much time as necessary in order to act on the petition. In this case it is clear that the board did not dismiss the second petition or refuse to act on it. Perhaps the majority means to imply that the second petition was "irrelevant" because the board acted on the second petition within 30 days after action on the first petition.

I do not agree with such a position. If this consideration is accepted as controlling it would, in effect, limit the board's power to entertain more than one petition for rehearing and would require the board to render its decision within a strict time limit, which

I believe leads to a result wholly unsanctioned by the statute or any rule. The majority's holding has the effect of making *all* second petitions irrelevant as to *time* within which to appeal under Rule 304, yet it does not go so far as to say the board may not consider a second petition for rehearing.[3] Must the board act upon such petitions within 30 days after its action on the first petition if an applicant's right to appeal under Rule 304 is to be preserved? I do not believe that the board can be certain (which I do not imply happened in this case) that no adverse appellate decisions will be rendered by the simple expedient, (1) of entertaining second petitions for rehearing and (2) delaying decision on them until the 30 day period of Rule 304 as here erroneously applied by the majority has run. Litigants and their attorneys should not be subjected to such a technical pitfall in pursuing an appeal. On the facts of this case, appellant had 5 days, from Friday, October 16, 1964, the date of the board's decision, to Wednesday, October 21, 1964, in which to receive notification of the board's grant-

[3]The majority appears to be following *In re Grier*, 52 CCPA 1081, 342 F. 2d 120, 144 USPQ 654, to the effect that the Patent Office has the authority to act in a case after an appeal has been filed in this court. I agree to the extent that the Patent Office may recede from its position or point out facts which may render an appeal to this court moot. To me it is not a question of the Patent Office exercising *jurisdiction* as it is acting as a party litigant. *In re Allen*, 28 CCPA 792, 115 F. 2d 936, 47 USPQ 471, is not the law insofar as it purports to hold that the Patent Office cannot act in a case after notice of appeal is filed in this court. In view of the majority's holding, I would urge litigants to continue to file second petitions for rehearing in order to clarify the issues for appeal, and the majority does not hold otherwise, but also file a notice of appeal within 30 days after action on the first petition as second petitions will not stay the time for filing a notice of appeal, contrary, in my view, to the rules.

ing of the second petition and file a notice of appeal. Under the majority's reasoning the result is the same no matter what day the board took action on the second petition.

There remains the question, where does a second petition for rehearing fit into the plan of appeal regarding timeliness? This must be determined before we can answer how much time after the board's "action on the [second] petition" did appellant have within which to file a notice of appeal? Considering only Rule 304 and 35 USC 7, it seems to me that Rule 304 should be liberally construed to preserve the power of the board without judicially imposed limitations to grant rehearings. Under this view appellant should be entitled to the same benefits as accrue from the filing of a first petition. On the facts of this case appellant would have 30 days after "action on the petition" filed as a result of the new decision. The term "petition" in Rule 304 would thus mean petitions filed while the board had jurisdiction.

However, I do not believe a forced construction of Rule 304 is necessary to arrive at a just resolution of the issue here. The Commissioner has enacted another rule which, contrary to the majority, I think must be considered. This is Rule 197(b) which provides in pertinent part:

> 197. *Action following decision* [by the Board of Appeals].
>
> (b) Any request or petition for rehearing or reconsideration, or modification of the decision, must be filed within thirty days from the date of the original decision, unless that decision is so

modified as to become, in effect, a new decision, and the Board of Appeals so states.

If Rule 197(b) is considered, the total plan of appeal contemplated by the Commissioner is apparent, the fact situation which developed below is understood, the board's decision is clear, and Rule 304 may be correctly understood.

Rule 197(b) is broadly worded and contemplates second petitions for rehearing. If a litigant can persuade the board to modify its "original decision" so it becomes, "in effect, a new decision" and the board "so states," a petition for rehearing is permitted.[4]

Rule 197(b) thus in effect recognizes that situations may develop wherein what the majority terms the "original decision," apparently the board's first decision, may become "modified," e.g., as the result of a (first) petition for rehearing, or on the board's own motion to correct error. It also recognizes that a litigant should have the *right* to submit a (second) petition for rehearing *outside* the time limit provided in Rule 304, i.e., 30 days, which is not subject to the provisions of Rule 304 grouped under par. (3) above. The rationale seems clear to me and is: where the

[4]It is readily apparent from an examination of Rule 197(b) that the first portion of the rule merely states the 30 day limitation concerning petitions for rehearing set forth in Rule 304. Lest silence be mistaken for my approval of this portion of Rule 197, however, it seems that it denies the right to submit petitions outside the 30 day period provided in Rule 304, while the board still has jurisdiction and is therefore contrary to the provisions of Rule 304 which allows that a litigant may file a petition for rehearing outside the 30 day limitation, but that any such petition or proceeding thereon will not extend the 60 day period therein provided.

"original decision" is so changed as to become a "new decision," *the post-decision review process begins all over again.* I would add that thus giving a litigant the *right* to *submit* a petition for such rehearing does not appear to be contrary to 35 USC 7.

Finally, Rule 197(b) recognizes that a controversy could occur as to whether a "modified" decision was a "new" decision. It provides, as I view it, that the right to file a (second) petition arises where the original decision "is so modified as to become, in effect, a new decision." This is the test which I think should be applied here. Rule 197(b) concludes with the phrase that the board must so state in its "new decision." It is not clear whether the intent of Rule 197(b) is that certain magic words such as "new decision" must appear or whether it is sufficient if as a matter of fact the board recognized that it has so modified the original decision that its second decision is, in effect, a new decision. As I view it, the test is one of substance not words. The board can no more denominate a second "decision" as a "new decision" or as not a "new decision" by the mere recitation or absence of such magic words. Whether a decision is *new* must be determined by what the board *did.*

Ignoring possible inconsistencies between Rule 197(b) and Rule 304, it seems clear to me that they fit together and they must be construed together.[5] The majority glorifies the titles of the two rules while ignoring their substance and meaning to say that Rule

[5]The confusion generated by the term "decision" in Rules 196 and 197 is readily apparent upon examination. I find therein the following terminology: "the decision," "its decision," "new decision," "final decision," and "decision," all of which may be ren-

197(b) applies to "it," the board, and Rule 304 applies to "us." Moreover, it seems to me the majority fails to appreciate the total *plan of appeal* as set forth by the Commissioner when *all* relevant rules are considered together.

First, it is clear that Rule 197(b) recognizes "original decisions" and "new decisions." Assuming that such a situation occurs, which "decision" is a dissatisfied litigant to appeal from? Rule 304 provides only that a litigant may appeal from "the decision" of the board. It seems to me that "the decision" includes both "original decisions" and "new decisions." Would anyone argue otherwise than that "the decision" in Rule 304 refers to the *controlling decision* of the board and a "new decision" controls over and supplants such an "original decision?" The majority seems to ignore the fact that an action on a petition for rehearing is not simply "reasoning" in support of the original decision; it may, in effect, be a *new decision* which is *"the decision"* specified in Rule 304 regarding timeliness.

Second, 35 USC 142 provides as follows:

> * * * appellant *shall* give notice [of the appeal] * * * to the Commissioner, and *shall* file in the Patent Office his reasons of appeal, * * * within such time after the date of *the decision appealed*

---

dered either by the primary examiner or the board. These Rules are the preceding procedure to Rule 304. The question here is which of the "decisions" the board is permitted to render under Rules 196 and 197 is "the decision" in Rule 304? Suffice it to say the proliferation of the term "decision" in Rules 196 and 197 hardly tells an applicant *what* decision he is to appeal from unless it is construed in *pari materia* with Rule 304 in light of 35 USC 142; and does not provide that the board may render "original decisions," so aptly coined in the majority.

from, not less than sixty days, as the Commissioner appoints. [Emphasis added.]

It is clear to me that the Commissioner acted in accordance with section 142 and provided, in Rule 304, 60 days within which to file notice of appeal, measured from "the date of *the decision appealed from.*" "The decision" in Rule 304 refers to "the decision appealed from" in section 142. 35 USC 6. And it seems to me "the decision" in Rule 304 refers to a "new decision" referred to in Rule 197(b), and if none exists, to the "original decision" of the board.

Did the board render a decision on the first petition for rehearing which, "in effect," so modified its original decision that it is a "new decision" under Rule 197(b)? The facts here seem clear that the board *did in fact* render a *new* decision as discussed, supra, and the board *in effect* so stated. Even the solicitor concedes, which the majority appears to overlook, that the real issue is whether the board's action was, in effect, a new decision. Dealing as he does with the practicalities arising within the Patent Office, it seems to me the solicitor would have no problem in recognizing that the board's action was a new decision, except for the fact that all 6 claims in appellant's application stand allowed and a seventh claim has been recommended by the board as being allowable. For reasons not stated, the solicitor apparently argues that the decision is not *new* because the board did not state some new basis for affirming a *rejection* of a claim.

The solicitor here is concerned with a somewhat unique problem of how to deal with an appeal from a board decision's *allowing* claims. He has phrased his

objection in the motion to dismiss the appeal in two ways, i.e., (1) the court lacks jurisdiction (no adverse decision) and (2) appellant, while admittedly filing notice of appeal from a decision of the board within 30 days as provided by Rules 197(b), 304, and 35 USC 142, has not appealed from a new decision (apparently because it is not an adverse decision). As I see it, the solicitor only advances, in substance, one objection. The majority, sua sponte, considers only Rule 304 and *in effect decides the board's decision is not "adverse,"* hence not an appealable decision.

The error of the majority is shown most clearly in footnote 1. Therein the majority states that the board's action of "September 21 provided additional *reasons* notwithstanding the board's action * * * constituted a 'new decision' to the extent the board changed its earlier position * * *." If the board's action was a new decision, then appellant had 60 days within which to file a notice of appeal. I conclude that it was a new decision, the board thought it was, the majority states it was, and the solicitor argues it was not. Yet the majority decision is to deny appellant's petition! This leaves but the alternative of dissent.

I cannot but approve of the acts of both the appellant and the board below. In its first decision the board carefully expressed its reasoning precisely why claims *1, 2* and *5* were not allowable. Pursuant to the board's reasoning and suggestions appellant submitted additional arguments in a petition for rehearing as to the non-allowed claims and as to the error in the board's interpretation of claims 3, 4 and 6. The board then reversed its original position and, addi-

tionally, assisted appellant with suggestions as to additional new claims. It set forth for the first time its support for its interpretation of claims 3, 4 and 6. Appellant then attempted to finalize the issues in dispute for appeal if necessary. The board obliged *because of the facts of this case* and granted a second petition for rehearing. This orderly procedure below is an assist to this court, i.e., defining the issues for appeal.

Following the reasoning of the majority, appellant should have appealed within thirty days from the board's second opinion. No matter how poorly the issues are drawn below, the majority says in effect you must file a notice of appeal and bring them to this court.

Appellant attempted to exhaust his remedies below as witnessed by the record. The majority opinion determines that the 30 days in which to file an appeal ran from the board's second opinion and not the third. Apparently the majority view is that appellant utilized a remedy (second petition for rehearing) which is outside Rule 304, in spite of 35 USC 7, 142, and with respect to which it considers the board's action to have been "irrelevant."

I believe the majority has "overlooked or misapprehended" factors which seem to me to be essential to a proper resolution of the issue presented by the solicitor's motion to dismiss the appeal. The result has been what seems to me to be a denial of appellant's right to appeal. It is for these reasons I dissent from the majority's disposition of this petition for rehearing.

United States Court of Customs and Patent Appeals

October Term, 1965

Patent Appeal No. 7596.

In the Matter of the Application
of
ARTHUR L. REESE

November 4, 1965

Subject Matter: Wear compensating die.
Serial No. 106,914.

Appeal dismissed on motion of Commissioner of Patents for failure timely to file the notice of appeal.

I, George E. Hutchinson, Clerk of the United States Court of Customs and Patent Appeals, do hereby certify that the above judgment is a true and correct copy of the judgment of said United States Court of Customs and Patent Appeals filed the 4th day of November, A.D. 1965, in the above-entitled appeal, as the same remain upon the files and records of said court.

Witness my hand and the seal of this court this 17th day of November, A.D. 1965.

(Signed) George E. Hutchinson
Clerk.

Decision of Board of Appeals, June 29, 1964

Before Dracopoulos and Bailey, Examiners-in-Chief, and Angel, Acting Examiner-in-Chief.

Bailey, Examiner-in-Chief.

This is an appeal from the final rejection of claims 1 through 6, all of the claims in the application.

The reply brief does not indicate any new point of argument presented in the Examiner's Answer. It appears to be but a continuation of argument. Thus, it has been filed in contravention to Rule 193(b) and has not been considered.

Claims 1 and 3 are reproduced as representative:

1. An extrusion die having a compression side and a discharge side, and a die hole therethrough defined by a hole wall extending from its compression side to its discharge side, said die hole including a working section of a diameter to produce an extrusion of a desired cross section, adjacent the compression side of said die, and means to prevent the shortening of said working section to maintain a describe consistency of material extruded through said die and thereby extend the normal useful life of said die, said means comprising a flaring section, said flaring section having a wall surface defining an angle of flare from said working section such as to cause said working section to grow at a rate commensurate with the rate of wear of said die on its compression side, to maintain a desirable consistency of material extruded through said die and thereby extend the normal useful life of said die.

3. An extrusion die having a compression side and a discharge side, and a die hole therethrough

defined by a hole wall extending from its compression side to its discharge side, said die hole including a working section of a diameter to produce an extrusion of a desired cross section, adjacent the compression side of said die, a relief section adjacent the discharge side of said die and of larger cross sectional area than said working section, and means to prevent the shortening of said working section to maintain a desirable consistency of material extruded through said die and thereby extend the normal useful life of said die, said means comprising an intermediate flaring section connecting the working section with said relief section, said flaring section having a wall surface defining an angle of flare from said working section such as to cause said working section to grow at a rate sufficient to compensate for enlargement of said hole and wear of said die on its compression side, to maintain a desirable consistency of material extruded through said die and thereby extend the normal useful life of said die.

The references:

Payne et al.	2,059,486	Nov. 3, 1936
Norman	2,902,715	Sept. 8 1959
Simon (Australia)	205,253	Jan. 3, 1957

The claims are drawn to a die. The die is for use in connection with extruding of various materials (such as animal foods) through holes to form compressed pieces. The animal foods are abrasive and tend to wear the die hole increasing its diameter. Proper compaction is dependent upon the ratio of hole length to

diameter, this being empirically determined for each composition extruded.

When the hole has the proper diameter to length ratio, compression is to the desired consistency. Due to wear increasing the diameter, the consistency becomes too soft.

The die is used in connection with a roller on its one face, which roller forces material into the uniform diameter hole. It is advantageous to have an introductory flare, as seen at 9 in Figure 1 (or other form of enlargement at the inlet), in order to facilitate feeding of compressed material to the uniform diameter portion called the working section.

The instant claims are based upon a species in which this flare portion is omitted. That this is the case is evident from the following considerations.

The roller operating on the abrasive animal food tends to wear the die on the inlet or compression side. This fact is well known to the art, as clearly shown by the specification and as is evident from a mere statement of the mechanical relation.

When there is an enlarged opening at the inlet end for the purpose above indicated, obviously any designer of ordinary skill would form the inlet portion of such depth that it would continue to perform its function throughout the life of the die, in spite of wear on the inlet or compression side. However, part of appellant's disclosure deals with compensating for shortening of the uniform diameter working section

due to wear. Thus, a species in which the inlet enlargement is omitted is the subject matter of the claims.

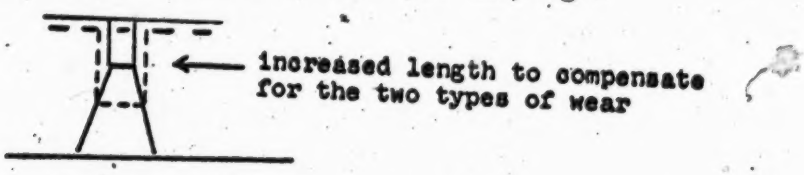
If the working section could be maintained of uniform diameter while its length is being shortened due to wear of the compression or inlet side, such shortening would cause an undesirable softening inconsistency of the material extruded.

Appellant has directed his efforts to alleviating the two deficiencies noted by providing means to increase the useful life of the die in spite of the wear on the compression or inlet side and in spite of the enlargement of diameter of the uniform diameter working section. His concept was to provide at the discharge end of such working section a flared hole. His concept deals with the degree of flare used, which degree of flare must be empirically determined for each die composition and each food composition extruded therethrough, since the rate of wear is dependent primarily on these two variables.

A single example has been given, which single example does not identify the particular composition of the die itself but identifies the animal food as dried sugar beet pulp.

In this particular example the included or flare angle is of the order of 3°, 34′ and 48″. This included angle of flare was empirically determined as being such that, as the working section diameter increased with wear and as its length was reduced due to wear of the working face, its length would increase in an

amount to compensate for both increase in diameter and degree of length reduction due to wear of the inlet or compression side of the die, e.g.:



The specification is clear that if these two wears are both present (due to failure to use the flared or otherwise enlarged inlet portion), both must be compensated for to increase the die life without undesirable decrease in product consistency. Of the two, the diameter increasing compensation appears to be the more important, since it appears to have the greater effect on the consistency of the extruded product.

There is no disclosure in the instant case of the degree of flare that would be required to compensate for the wear of the die on its compression side *only*.

In addition, there is one further feature. These dies are subject to great pressures in the direction of the hole axis. Thus, for any given composition of the die there must be a minimum thickness of the die to yield sufficient mechanical strength. Where the die opening portions indicated above, i.e. the working section and flared section, aggregate insufficient dimension for minimum thickness, the minimum thickness is used, and a cylindrical opening axially aligned with the other holes already mentioned and, of course, of a diameter at least equal to the maximum diameter of the flared portion is provided. This is called the relief section of the over-all hole.

This last feature is, in and of itself, a well-known feature in the art for its usual purpose of providing a die having sufficient thickness for mechanical strength considerations. This feature is specified in claims 2, 3, 5 and 6, and, as the Examiner points out on page 5, both Norman and Simon disclose the same.

Appellant's arguments for patentable significance of this old feature occurring in summarized form on page 21 of the brief are not persuasive of patentable significance, since this is an old feature added solely for its old purpose of providing minimum mechanical strength.

Appellant's argument that his relief section has constant diameter does not indicate anything of patentable significance, since each of the references clearly discloses the same.

Thus, we will turn to the essential point as to patentability of the instant claims.

Claims 3, 4 and 6 present the first question to be decided.

These claims specify compensating for both wear on the inlet or compression side of the die and increase in cross section of the uniform diameter working section due to wear. These three claims recite the significant aspect in equivalent terms represented by claim 3, starting with line 9, as this claim is reproduced in the brief.

The rejection is on the patent to Payne et al. This patent discloses a machine and die for the same purposes as the instant case. It has the same disclosure

as to the advantages of having an enlarged or flared inlet portion and a uniform diameter working section which determines the final compression due to its length. In addition, the working section is followed by a flared portion disclosed, however, for a completely different purpose. This patent does not disclose adding additional metal to provide when necessary the minimum thickness required for mechanical considerations, this being the feature disclosed by the other two references, which feature would merely be for its known purpose in connection with the Payne et al. die, and thus is an obvious contribution to the combination.

The flare in the Payne et al. die is disclosed for the purpose of slowly relieving the resilient compression of the animal food discharged from the working section so as to prevent cracking of the compressed product. The degree of flare is indicated in the two paragraphs bridging the two columns on page 2 of this patent, with the second and third paragraphs in the second column indicating the purpose.

Appellant has clearly indicated in his brief, particularly at pages 15 through 17, that the angle of flare would be less than 1° for a die corresponding to appellant's single example on page 7 of the instant specification.

The Examiner's rejection is based on the proposition that, insofar as the claims of the instant case are concerned, they do not define this difference.

As to claims 3, 4 and 6 under consideration, we cannot agree.

As indicated above, the particular flare is for a particular die composition when the die is used for a particular composition being extruded. The flare must be empirically determined for compensating for the two types of wear. This angle is far in excess of the angle used by Payne et al. Thus the Payne et al. structure will not inherently function for compensating these two characters of wear, as appellant shows.

Further, as we have indicated above, in the light of the two main variables, it is only possible to define the degree of flare consonant with appellant's concept by correlating flare with the function it is to perform.

All claims were amended to specify that the flaring section was means with a degree of flare to maintain a desirable consistency of material extruded through said die and thereby extend normal useful life of said die by compensating for wear, as seen by inspecting quoted claim 3.

The Examiner has, as indicated, rejected on Payne et al. on the ground that *no structure is recited* defining over Payne et al. In making this holding he appears to recognize that Payne et al. will not perform the function of maintaining desirable consistency of material extruded through the die with wear from the two causes indicated.

It is his view that this functional statement, even though attributed to the means, namely the flaring section, is not a recitation of structure and that *other*

wise the claims (including claims 3, 4 and 6 now under consideration) are readable upon Payne et al.

Consonant with appellant's viewpoints as to these claims, we cannot agree. The function is the function of the means recited. It limits such means and, under the provision of 35 U.S.C. 112, third paragraph, it constitutes a structural limitation on the claims.

Thus, the claimed structure properly defines a combination performing the indicated function that Payne et al. cannot perform. Therefore, we cannot sustain the rejection of claims 3, 4 and 6.

However, claims 1, 2 and 5 present a different question. As already indicated, the degree of flare to compensate for *only the wear of the die on its compression side* is not indicated in the instant case.

As already indicated, when an enlarged inlet to the working section (in the form of a flare as in Payne et al. or of other forms, as in Norman or Simon) is present, wear on the compression side will have no effect on the consistency of the material extruded until such time as the enlarged inlet portion has completely worn away.

In considering claims 1, 2 and 5, we find that they have no recitation that the working section communicates directly with the compression side of the die. For this reason the flare is unnecessary to compensate for a wear which has no effect on consistency.

Further there is, as already indicated, no disclosure in the instant case of a degree of flare necessary to compensate for wear on the die compression side

when the working section does directly communicate with such compression side. The only indication appears to be that much less compensation is needed than for the combined causes of wear involved in the single example given.

It may well be that the Payne et al. degree of flare will completely compensate for wear on the compression side after the die is worn down to beyond the enlarged or flared inlet end. If such is the case, claims 1, 2 and 5 would define only the structure of Payne et al. which would inherently perform the function.

In the absence of any evidence to the contrary, we find that claims 1, 2 and 5 define no structure differing from Payne et al., since these claims are sufsufficiently broad to embrace having the enlarged inlet section and some undisclosed degree of flare which might be the degree of flare of Payne et al. for compensating for die face wear thereafter.

Thus, we will sustain the rejection of claims 1, 2 and 5, since we have no evidence presented for consideration leading to a contrary conclusion.

The decision of the Examiner is affirmed as to claims 1, 2 and 5 but is reversed as to claims 3, 4 and 6.

AFFIRMED-IN-PART

Decision of Board of Appeals, September 21, 1964

Before Dracopoulos and Bailey, Examiners-in-Chief, and Angel, Acting Examiner-in-Chief.

Bailey, Examiner-in-Chief.

This is a petition for reconsideration of our decision dated June 29, 1964.

The first point for consideration is appellant's contention that we placed an unreasonable limitation on claims 3, 4 and 6, the rejection of which we reversed. His contention is that the presence of the flare portion 9 or its absence has no effect on compensation of length of the working section.

This allegation is true only of compensation for increase in diameter of the working section. So long as the flare 9 is present, there is no need for compensation for wear of the surface of the die.

Appellant may be right when he says that a flare such as 9 could be formed which will disappear before the useful life of the die has ended and that when a die is so constructed, after the flare has disappeared the two types of compensation required by claims 3, 4 and 6 will occur.

As to this allegation, we point out that claims 3, 4 and 6 read upon a die only if there is no flare present, because so long as the flare is present, no compensation is needed for wear on its compression side. Thus, we adhere to our stated first point with respect to claims 3, 4 and 6, while agreeing with appellant that this construction (which, in our opinion, is made necessary by the terms of the claims due to their

requirement of compensation for wear of the die on its compression side) means that these claims do not properly protect appellant's concept as to compensation for the major wear alone.

Appellant's second point is that we were in error in our treatment of claims 1, 2 and 5 and the reason why we were in error. This occurs in the petition starting with the second paragraph on page 4.

We have considered appellant's contentions and find that he is correct. As will be apparent from our opinion, we erroneously held that the degree of flare to compensate for surface wear would be less than the degree of flare for compensating for increase in working section diameter plus surface wear. As appellant points out, the angle must be greater, since the compensation is less and the greater the angle the less there will be increase in length to compensate for wear. Thus, our holding that we had no basis for distinction over Payne et al. (who completely lack the concept or the means of the instant case) was in error. Therefore, we modify our decision and reverse the rejection of claims 1, 2 and 5.

In view of the petition, we are of the opinion that the present claims, consonant with the tenor of the petition, do not properly protect the novel concept which is clearly patentable over the prior art, in view of the fact that anyone could compensate for increase in working section diameter only and no claim would be directly infringed.

Thus, for the purpose of having a claim protect appellant's concept as concerns the wear which in-

creases the diameter of the working section, we recommend allowance of a claim identical with claim 3 if amended in the following particulars, claim 3 being referred to in the form as it appears in our opinion:

In lines 8 and 9, cancel "to prevent the shortening of said working section,"

and in line 17, cancel "and wear of said die on its compression side."

A claim in the amended form suggested would be allowable over the art before us as defining appellant's concept covering compensation for wear for increase in working section diameter, which would involve the same difference over Payne et al. (namely, degree of flare) that causes appellant's novel concept as defined in the other claims to be patentable and would embrace a form of die either with or without a flare such as 9.

The petition is granted to the extent indicated above.

Decision of Board of Appeals, October 16, 1964

Before Dracopoulos and Bailey, Examiners-in-Chief, and Angel, Acting Examiner-in-Chief.

Bailey, Examiner-in-Chief.

This is a second petition for reconsideration in the instant case.

It is not our custom to entertain a second petition for reconsideration outside of the period specified by Rule 197(b). However, under the special facts of the

instant case, we are making an exception and will entertain the instant petition.

The instant petition is presented with an allegation that we failed to understand appellant's allegation of error in the first petition for reconsideration as to our holding relative to claims 3, 4 and 6. These are the claims which specify compensating for both wear on the inlet or compression side of the die and for increase in cross-section of the uniform diameter working section due to wear of these two parts.

Appellant discloses a die having an inlet or compression side 1, as shown best in Figure 2. Communicating with this compression side is a countersink 9. This countersink communicates at its other end with the uniform diameter working section 7.

Under the disclosure the compression side 1 wears away due to the effect of the materials being fed. Under the disclosure the uniform diameter working section enlarges due to the wear effect of the material passing therethrough. For the same reason that the working section wears away and increases in diameter, the countersink, when present, will also wear, as correctly stated in the petition with the schematic showing of approximately uniformity of wear.

We pointed out in our opinion and in our first decision on petition for reconsideration that wear of the compression side would have no effect on shortening the working section, so long as a countersink is present.

We call attention to the first petition for reconsideration, page 2, starting with line 12, which states:

> "* * * In any event, the countersinks [sic] will wear down as the compression side of the die wears and the length of the work section of the die hole will accordingly become shorter with wear on the compression side of the die in essentially the same manner as if the countersinks were not present in the die at all. Countersinks therefore, will not have to be of such depth as to outlive the useful life of a die, as conjectured by the Board in paragraph 4 of page 3 of its decision."

It will be seen that appellant recognizes the countersink is *not* the compression side of the die but is a feature in addition to the compression side of the die. He speculates, apparently, that the countersink wear and the compression side wear are the same. We speculated that the compression side wear due to the scrubbing action of the feed means would be the greater so that the countersink would eventually disappear. However, the main point is that the compression side and countersink are different and whether the claims under consideration *as drafted* read on a die having a countersink.

While appellant is, of course, entirely correct in stating that wear of the countersink will shorten the length of the work section and that any claim which so states would involve a correct definition, the claims under consideration, as we have before pointed out, and as is evident from the terminology of claim 3 that we reproduced, are restricted to *wear of the compression side shortening the length of the working section.* As shown by appellant's sketch, when there

is a countersink, no matter how much wear there may be of the compression side, *so long as a countersink is present, wear of the compression side does not shorten the work section.* It is wear of the countersink that does this.

Therefore, when, as set forth in claims 3, 4 and 6, compensation is for "wear of said die on its compression side," since such effects length of working section only in the absence of a countersink, these claims are so restricted.

If the first and second petitions are intended to state that wear of the countersink will shorten the working section and that claims 3, 4 and 6 are so restricted, both the first petition as to this point and the instant petition as to this point are in error.

The petition has been granted to the extent that we have considered the same but is denied with respect to making any change in our opinion in the case or opinion on the first request for reconsideration.